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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,244	11/28/2001	Daniel Richard Schaefer	594826-001	3771

27805 7590 02/16/2005
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EXAMINER

BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3641

The 10/8/04 appeal brief is still defective for the reasons set forth in the 1/4/05 Office action.

A telephone interview was held with applicants attorney, Mark Levy, on 1/14/05 in which there was discussion of the 1/4/05 Office action (which held the 10/8/04 brief defective).

Each of the issues set forth in said 1/4/05 Office action were discussed in detail such that applicant should be fully aware of what is required so that a new substitute appeal brief will not be held defective for failure to comply with the Rules.

The following is exemplary only, of the discussion held.

Mr. Levy indicated that the issue of the brief listing the withdrawn claims as among the appealed claims was a minor issue which presumably should not have been raised.

In response, it was pointed out that the brief was also defective for other reasons and that it was logical and proper for the Office action to require all of the deficiencies to be corrected, not just the most important deficiencies.

Mr. Levy did not believe that the 10/8/04 brief still referred to "Table 1", until directed to the second full paragraph on page 6 of the 10/8/04 brief (as per the bottom of page 6 of the 1/4/05 Office action).

Mr. Levy indicated he did not feel it was proper to indicate as new evidence, the reference in the brief to the MER Corp. in Arizona as the supplier or source of their fullerines (the specification itself on page 4 refers to a different company SES Inc. in Houston, TX), since one should not expect the inventor to retain the same company as

his source of fullerenes for 10 years (the present application is a continuation of 08/376846 filed 1/23/95 (continuation filed after a decision by The Board affirming the examiner)).

It was pointed out to Mr. Levy that the passage of time has no bearing on whether something represents new evidence and, that said second full paragraph on page 6 of the 10/8/04 brief specifically states that this company, MER Corp., was the source of the samples discussed in Table 1 below (Table 1 however, having been deleted in the preparation of the 10/8/04 brief because it was specifically stated as representing new evidence).

As to the issue of Grouping of the Claims, the 10/8/04 brief states that in regard to issue B (whether claims 4-8, 10-14, 16-19 are unpatentable under 35 USC 112, second paragraph) (bottom of page 5 of the 10/8/04 brief), that each claim stands or falls on its own merits, but instead of providing arguments for separate patentability of each claim, pages 8 and 9 of the brief only recite what each claim covers.

Mr. Levy indicated that to require him to actually present reasons for separate patentability of each claim would prevent the appeal from going forward.

Whether or not the case goes forward depends upon whether or not a new brief is submitted which complies with the rules.

If it is desired to have each claim stand or fall on its own merits, actual reasons or arguments for separate patentability must be presented to be in compliance with the Rules (the Rule itself specifically states that merely pointing out what a claim recites will not be considered an argument for separate patentability of the claim).

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The examiner in the 1/4/05 Office action did not notice that the 10/8/04 brief on page 1 under the heading "Related Party in Interest", failed to identify the Appeal No. and Board decision in parent case 08/376845 and, the 10/8/04 brief is hence also deficient in this respect.

Additionally, all appeal briefs filed after Sep. 2004, must be in the new format required by 37 CFR 41.37 (replacement for former section 1.192).

A copy of section 41.37 is provided for applicants convenience. Note particularly items 2, 5, 7, 10.

Since these additional deficiencies were not pointed out in the 1/4/05 Office action, a new period for response will begin with the mailing date of this Office action.

Appellant is required to comply with provisions of 37 CFR 41.37(c) in regard to all issues raised above and, in the 1/4/05 Office action. To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 41.37(c) within ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication.


Extensions of time may be granted under 37 CFR 1.136.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.



HARVEY E. BEHREND
PRIMARY EXAMINER

Behrend/vs
February 7, 2005

Content and format of the appeal brief (§ 41.37)

- The brief must contain the following items (§ 41.37(c)):
 1. **Real party in interest** (similar to former § 1.192).
 - A statement identifying by name the real party in interest even if the party named in the caption of the brief is the real party in interest.
 - X 2. **Related appeals and interferences** (similar to former § 1.192).
 - Identification of all other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision.
 3. **Status of claims** (similar to former § 1.192).
 - The status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of the appealed claims.
 4. **Status of amendments** (same as former § 1.192).
 - A statement of the status of any amendment filed subsequent to final rejection.
 - X 5. **Summary of claimed subject matter** (replacing "summary of invention").
 - A concise explanation of the subject matter defined in each of the independent claims involved in the appeal,
 - Must refer to the specification by page and line number, and to the drawing, if any, by reference characters.
 - For each independent claim involved in the appeal and for each dependent claim argued separately,
 - Every means plus function and step plus function must be identified, and
 - The structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.
 - X 6. **Grounds of rejection to be reviewed on appeal** (replacing "issues for review" and "grouping of claims").
 - Example: Claims 1 to 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. X.
 7. **Argument** (has been revised).
 - ✓ ■ A separate heading is required for each ground of rejection.
 - X ■ Any claim(s) argued separately should be placed under a subheading.
 - X ■ A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.
 - When multiple claims subject to the same ground of rejection are argued as a group, the Board may select a single claim from the group to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.
 8. **Claims appendix** (similar to former § 1.192).
 - A copy of the claims involved in the appeal.
 9. **Evidence appendix** (new)
 - Copies of any evidence entered and relied upon in the appeal.
 - X 10. **Related proceedings appendix** (new)
 - Copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section.

Final Rules: Practice Before the BPAI
Appeal Brief - § 41.37

Non-compliant appeal briefs (§ 41.37(d))

- If a brief does not comply with the requirements set forth in § 41.37, the appellant will be notified of the reasons for noncompliance.
 - Appellant will be given **1 month or 30 days** from the mailing of the notification of non-compliance, whichever is longer, to file an amended brief. See §41.37(d).
 - The time period for filing the amended brief is extendable under:
 - §§ 1.136(a) and (b) for patent applications (e.g., may extend up to five months after the two month time period); and
 - § 1.550(c) for ex *parte* reexamination proceedings. See §41.37(e).